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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,569	08/31/2001	Bertrand Berthelot	1807.1743	9399
5514	7590	04/20/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			STEVENS, ROBERT	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,569

Applicant(s)

BERTHELOT ET AL.

Examiner

Robert M Stevens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications: **Application No. 09/942,569** amendment filed 11/29/2004 to the original application filed 8/31/2001 by Berthelot et al. entitled "Method and Device for Adapting the Content of Documents of an Information Server".
2. The Office withdraws objections raised in the First Action on the Merits (FAOM) concerning the specification, in light of the amendment.
3. The Office withdraws objections raised in the FAOM concerning the Abstract, in light of the amendment.
4. The Office maintains objections raised in the FAOM concerning priority.
5. The Office maintains objections raised in the FAOM concerning the drawings (in particular Fig. 9, which merely depicts several empty boxes connected via arrows, but contains no legends describing the boxes and thus requires one to search through the specification to determine what information Fig. 9 is trying to convey).
6. The Office withdraws claims rejections under 35 USC 101 raised in the FAOM, in light of the amendment.

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7. The Office withdraws claims rejections under 35 USC 112 2nd paragraph raised in the FAOM, in light of the amendment. However, the Office rejects claim 17 (17₁ and 17₂) under 35 USC 112 2nd paragraph, as necessitated by this amendment.

8. The FAOM rejections of claims 1-7 and 9-17 under 35 USC 103(a) as being unpatentable over Gupta in view of Greer, have been withdrawn as necessitated by amendment.

9. The FAOM rejection of claim 8 under 35 USC 103(a) as being unpatentable over Gupta in view of Greer and Cole, have been withdrawn as necessitated by amendment.

10. Claims 1-18 are pending. Claims 1, 11, 16 and 17 are independent.

Priority

11. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

12. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Drawings

13. The drawings are objected to as failing to comply with 37 CFR 1.84(o) because suitable descriptive legends are required for the understanding of Fig. 9.

14. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 17₁ and 17₂ recite the limitation "computer-readable medium" in line 2. There is insufficient antecedent basis for this limitation in the specification. This term/phrase does not appear in the specification.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1-33 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Kanevsky (US Patent No. 6,300,947, filed Jul. 6, 1998 and issued Oct. 9, 2001, hereafter referred to as "Kanevsky") in view of Narayanaswamy (US Patent No. US 5,764,229, issued Jun. 9, 1998, hereafter referred to as "Narayanaswamy").

Regarding independent method claim 1, Kanevsky discloses:

A method of transcoding content of documents on an information server (Abstract), comprising the steps of:
receiving a request from a user for access to one a first document situated on the information server, said access request beginning a communication session; (Fig. 1 #102, 103 and 108)
analyzing the characteristics contained in said access request; (Abstract, esp. discussing screen size and window information) and
transcoding content of at least a second document situated on the information server according to said characteristics, (Abstract and Fig. 1 #107)

Kanevsky, however, does not explicitly disclose:

... ;
... ;
... ; and
... , the transcoding of said second document taking place before reception of a request for access to said second document.

Narayanaswamy, though, discloses:

... ;
... ;
... ; and

... , the transcoding of said second document taking place before reception of a request for access to said second document. (col. 3 lines 54-58 and col. 4 lines 1-8)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Narayanaswamy for the benefit of Kanevsky, because to do so would have allowed a transcoding system implementer to decrease power and bandwidth usage, as taught by Narayanaswamy in col. 1 lines 42-48 and col. 3 lines 3-8. These references were all applicable to the same field of endeavor, i.e., document transcoding.

Regarding claim 2, which is dependent upon claim 1, Kanevsky further discloses:

wherein the transcoding step is interrupted on reception of a request for access to a document on the information server. (Fig. 1 #107 and col. 7 lines 25-41)

Regarding claim 3₁, which is dependent upon claim 1, Kanevsky further discloses:

wherein, at the transcoding step, content of all documents situated on the information server is transcoded according to said characteristics. (Abstract and col. 7 lines 25-41)

Claim 3₂ is substantially similar to claim 3₁, and therefore likewise rejected.

Regarding claim 4₁, which is dependent upon claim 1, the limitations of claim 1 have been previously discussed.

Kanevsky, however, does not explicitly disclose:

wherein, at the transcoding step, content of only some documents situated on the information server is transcoded according to said characteristics.

Narayanaswamy, though, discloses:

wherein, at the transcoding step, content of only some documents situated on the information server is transcoded according to said characteristics. (col. 7 lines 50-58)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Narayanaswamy for the benefit of Kanevsky, because to do so would have allowed a transcoding system implementer to decrease power and bandwidth usage, as taught by Narayanaswamy in col. 1 lines 42-48 and col. 3 lines 3-8. These references were all applicable to the same field of endeavor, i.e., document transcoding.

Claim 4₂ is substantially similar to claim 4₁, and therefore likewise rejected.

Regarding claim 5₁ Kanevsky further discloses:

further comprising a step of determining an order of processing for the transcoding of the documents situated on the information server.
(Abstract, esp. discussing hierarchically linked ... pages, and col. 11 lines 25-63 discuss priority decisions)

Claim 5₂ is substantially similar to claim 5₁, and therefore likewise rejected.

Regarding claim 6₅₋₁ Kanevsky further discloses:

wherein, at the determination step, the order of processing of the documents is determined according to frequency of access to the documents on the information server. (col. 11 lines 25-63, esp. "statistics of visits to web sites")

Claim 6₅₋₂ is substantially similar to claim 6₅₋₁, and therefore likewise rejected.

Regarding claim 7₆₋₅₋₁, which is dependent upon claim 6, the limitations of claim 6 have been previously discussed.

Kanevsky, however, does not explicitly disclose:

wherein only some documents having a frequency of access greater than a threshold amount are transcoded.

Narayanaswamy, though, discloses:

wherein only some documents having a frequency of access greater than a threshold amount are transcoded. (col. 7 lines 50-58, it being merely a matter of obvious design choice as to what criteria are used as the basis for the decision to transcode)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Narayanaswamy for the benefit of Kanevsky, because to do so would have allowed a transcoding system implementer to decrease power and bandwidth usage, as taught by Narayanaswamy in col. 1 lines 42-48 and col. 3 lines 3-8. These references were all applicable to the same field of endeavor, i.e., document transcoding.

Claim 7₆₋₅₋₂, which is dependent upon claim 6, is substantially similar to claim 7₆₋₅₋₁, and therefore likewise rejected.

Regarding claim 8₅₋₁ Kanevsky further discloses:

wherein, at the determination step, the order of processing of the documents is determined according to a tree of the documents on the information server. (Abstract, esp. re: "hierarchically linked ... pages")

Claim 8₅₋₂ is substantially similar to claim 8₅₋₁, and therefore likewise rejected.

Regarding claim 9₁ Kanevsky further discloses:

wherein, at the analysis step, the characteristics contained in said access request are chosen amongst characteristics of a terminal of said user, characteristics of a communication network between said user and the information server, and characteristics peculiar to the user. (Abstract, esp. re; screen size)

Claim 9₂ is substantially similar to claim 9₁, and therefore likewise rejected.

Regarding claim 10₁, which is dependent upon claim 1, the limitations of claim 1 have been previously discussed.

Kanevsky, however, does not explicitly disclose:

further comprising a step of eliminating said transcoded documents on the information server at the end of the communication session between said user and the information server.

Narayanaswamy, though, discloses:

further comprising a step of eliminating said transcoded documents on the information server at the end of the communication session between said user and the information server. (col. 7 lines 59-63, it being merely a matter of obvious design choice as to whether one persists or eliminates such documents after transmission to client)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Narayanaswamy for the benefit of Kanevsky, because to do so would have allowed a transcoding system implementer to decrease power and bandwidth usage, as taught by Narayanaswamy in col. 1 lines 42-48 and col. 3 lines 3-8. These references were all applicable to the same field of endeavor, i.e., document transcoding.

Claim 10₂, which is dependent upon claim 2, is substantially similar to claim 10₁, and therefore likewise rejected.

Claim 11 is directed to a device comprised of the means for implementing the method of claim 1. As such claim 11 is substantially similar to claim 1, and therefore likewise rejected.

Claim 12 is substantially similar to claim 5 (i.e., claims 5₁ and 5₂), and therefore likewise rejected.

Claims 13₁ and 13₂ are substantially similar to claims 10₁ and 10₂, respectively, and therefore likewise rejected.

Regarding claim 14₁₁, which is dependent upon claim 11, the limitations of claim 11 have been previously discussed.

Kanevsky, however, does not explicitly disclose:

wherein said receiving means, said analyzing means, and said transcoding means are incorporated in:
a microprocessor;
a read only memory adapted to store a program for transcoding the content of documents; and
a random access memory comprising: registers transcoded to store variables modified during the running of said program.

Narayanaswamy, though, discloses:

wherein said receiving means, said analyzing means, and said transcoding means are incorporated in:
a microprocessor; (Fig. 2 #10)
a read only memory adapted to store a program for transcoding the content of documents; (Fig. 2 #16) and
a random access memory comprising: registers transcoded to store variables modified during the running of said program. (Fig. 2 #14)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Narayanaswamy for the benefit of Kanevsky, because to do so would have allowed a transcoding system implementer to decrease power and bandwidth usage, as taught by Narayanaswamy in col. 1 lines 42-48 and col. 3 lines 3-8. These references were all applicable to the same field of endeavor, i.e., document transcoding.

Claim 14₁₂, which is dependent upon claim 12, is substantially similar to claim 14₁₁, and therefore likewise rejected.

Claim 15₁ is directed to a server comprised of the means for implementing the method of claim 1. As such claim 15₁ is substantially similar to claim 1, and therefore likewise rejected.

Claim 15₂ is directed to a server comprised of the means for implementing the method of claim 2. As such claim 15₂ is substantially similar to claim 2, and therefore likewise rejected.

Claim 16₁ is directed to a communication network comprising at least one server comprised of the means for implementing the method of claim 1. As such claim 16₁ is substantially similar to claim 1, and therefore likewise rejected.

Claim 16₂ is directed to a communication network comprising at least one server comprised of the means for implementing the method of claim 2. As such claim 16₂ is substantially similar to claim 2, and therefore likewise rejected.

Claim 17₁ is directed to a computer program on a computer readable medium for implementing the method of claim 1. As such claim 17₁ is substantially similar to claim 1, and therefore likewise rejected.

Claim 17₂ is directed to a computer program on a computer readable medium for implementing the method of claim 2. As such claim 17₂ is substantially similar to claim 2, and therefore likewise rejected.

Regarding claim 18₁₃₋₁₁ Kanevsky further discloses:

wherein said determining means and said eliminating means are incorporated in:

*a microprocessor; (Fig. 2 #10)
a read only memory transcoded to store a program for transcoding the content of documents; (Fig. 2 #16) and
a random access memory comprising registers transcoded to store variables modified during the running of said program. (Fig. 2 #14)*

Claim 18₁₃₋₁₂ is substantially similar to claim 18₁₃₋₁₁, and therefore likewise rejected.

Response to Arguments

19. Applicant's arguments filed 11/29/2004 have been fully considered but they are not persuasive.

Applicant's remarks on pages 9-10 of the amendment concerning the "Specification", "Abstract", "Drawings", "Rejection of Claims Under 35 USC 101", and "Rejection of Claims Under 35 USC 112, 1st and 2nd paragraphs" raised in the FAOM have been addressed above.

It is respectfully noted that Applicant's amendment to the claims significantly changes the scope of the claimed invention as a whole. As such, Applicant's

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arguments (pages 10-12 of the amendment) concerning FAOM rejections of claims 1-17 under 35 USC 103(a) have been rendered moot.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

<i>US Patents</i>	
Makipaa et al	6,556,217
Weiss et al	6,738,951
Schwerdtfeger et al	6,829,746
Hind et al	6,715,129
Dutta et al	6,615,212
Adams et al	6,457,030
Mighdoll et al	5,918,013
Brown et al	5,887,133

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The current fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Additionally, the main number for Technology Center 2100 is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens
Reg. No. 47,972
Art Unit 2176
Date: April 17, 2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

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